



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Admistrative Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,281	08/03/2005	Laura Quaranta	70220	9446
26748	7590	04/02/2008		
SYNGENTA CROP PROTECTION, INC. PATENT AND TRADEMARK DEPARTMENT 410 SWING ROAD GREENSBORO, NC 27409			EXAMINER	
			QAZL SABHA NAJM	
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
04/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/544,281	Applicant(s) QUARANTA ET AL.
	Examiner Sabiha Gazi	Art Unit 1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 November 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 7-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-146/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

Non-Final Office Action

Claims 1-4, and 7 -20 are pending.

Claim Rejections - 35 USC § 103—1st Rejection

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 7-9, 11, 12, 14, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over OMURA et al.¹.

The reference teaches avermectin derivatives having high antiparasitic activity, which embraces Applicant's claimed invention. See the entire document especially formula (1) and lines 1-67 in col. 1, lines 1-58 in column 2, Tables 1-8 in column 37-45; examples and claims.

The reference teaches avermectin derivatives of formula (I) having higher antiparasitic activity, which have high antiparasitic activity. The carbon atom at the 4"-position represents **a single or double bond**; a line ---- between R2 and a carbon atom at the 5-position represents **a single or double bond**. See lines 58-61 in column 1.

Instant claims differ from the reference in that they are of different generic scope. Specific compound are disclosed in present application for example see Tables 9 and 10 on pages 76 and 77. See lines 1-67 in column 1 and lines 1-58 in column 2, examples and claims.

¹ US Patent 6,605,595 B1

It had been held by Courts that the indiscriminate selection of "some" from among "many" is considered *prima facie* obvious. In re Lemin, 141 USPQ 814 (1964); National Distillers and Chem. Corp. V. Brenner, 156 USPQ 163.

The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare compounds embraced by the genus of the above cited references with the expectation of obtaining additional beneficial compounds for the same use such as pesticides. The instant claimed compounds would have been suggested to one skilled in the art at the time of invention was made.

Instant claims are broader than the prior art.

One having ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render *prima facie* obvious a species falling within the genus. In re Susi, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in Merck & Co. V. Biocraft Laboratories, 874 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

In absence of any criticality and/or unexpected results presently claimed invention is considered obvious.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103—2nd Rejection

Claims 1-4, 7 and 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over BANKS, Joseph². See the entire document especially abstract of the invention, compounds of formula (I) on page 2, lines 4-12 on page 4, lines 4-25 on page 5 examples 1-23 and claims.

Instant claims differ from the reference in that they are of different generic scope. Specific compound are disclosed in present application for example see Tables 9 and 10 on pages 76 and 77. See lines 1-67 in column 1 and lines 1-58 in column 2, examples and claims.

It had been held by Courts that the indiscriminate selection of "some" from among "many" is considered prima facie obvious. In re Lemlin, 141 USPQ 814 (1964); National Distillers and Chem. Corp. v. Brenner, 156 USPQ 163.

The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare compounds embraced by the genus of the above cited references with the expectation of obtaining additional beneficial compounds for the same use such as pesticides. The instant claimed compounds would have been suggested to one skilled in the art at the time of invention was made.

Instant claims are broader than the prior art and are generically taught.

² WO 93/15099

One having ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render *prima facie* obvious a species falling within the genus. In re Susi, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in Merck & Co. V. Biocraft Laboratories, 874 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

In absence of any criticality and/or unexpected results presently claimed invention is considered obvious.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Response to Remarks

- A. Examiner respectfully disagree that OMURA does not teach single bond between R1 and 4", the reference teaches that "The carbon atom at the 4"-position represents **a single or double bond**; a line ---- between R2 and a carbon atom at the 5-position represents **a single or double bond**", see lines 58-61 in column 1.
- B. Arguments are found persuasive because OMURA does not teach monosaccharide group at C-13 position therefore claims 10, 13, 15 and 17 are not obvious over OMARA et al.

Art Unit: 1612

Applicant's arguments on OMURA et al. were fully considered but are not found persuasive therefore the rejection is maintained.

C. Applicant argues that OMURA teaches a single CH₂, claims 12 and 13 require at least two carbon chains and claims 11, 17, 18 and 20 require at least a three carbon chains. Examiner disagrees because in case when CH₂ is taught ethyl and propyl groups are considered obvious due to homologues. Further Applicant argues that OMURA does not teach alkene group as claimed in claims 17, 18 and 20. Examiner disagrees because the reference teaches alkene.

D. Applicant argues that OMURA teaches a single CH₂ and does not teach R₁ as CH₂-OH or CH₂-CH₂-OH therefore claim 19 is not obvious over OMURA. Examiner agrees.

E. In order to advance the prosecution Applicant may consider calling the Examiner to discuss the issues surrounding this application.

F. Finality of the rejection is withdrawn.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day except Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krass Frederick can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sabiha Qazi/
Primary Examiner, Art Unit 1612